



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

HC

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/112,020	07/08/98	AOKI	K 1945-104R

LM02/0211

VINCENT M DELUCA
ROTHWELL FIGG ERNST & KURZ
555 13TH STREET NW
SUITE 701 EAST
WASHINGTON DC 20004

EXAMINER

URBAN, E

ART UNIT	PAPER NUMBER
----------	--------------

2746

8

DATE MAILED: 02/11/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/112,020

Applicant(s)

Aoki et al.

Examiner

Edward F. Urban

Group Art Unit

2746



☒ Responsive to communication(s) filed on Nov 30, 1999

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1035 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-26 is/are pending in the application.
Of the above, claim(s) _____ is/are withdrawn from consideration

☒ Claim(s) 1-18 is/are allowed.

☒ Claim(s) 19-26 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 5

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit:

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-26 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The above claims, as they are currently amended, recite a mobile communication terminal containing a satellite transceiver and a portable set disconnectable to the satellite transceiver and having a terrestrial transceiver. However, throughout the disclosure, the mobile communication terminal equipment has been defined as being mounted in a vehicle, such as an automobile and the inventive concepts of such have been directed to a mobile communication terminal equipment mounted in a vehicle. These claims, as now recited, encompass a mobile communication terminal that may be entirely portable; that is, a mobile communication terminal in which the satellite transceiver is portable. Such a feature is not supported by the original patent disclosure and therefore was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventor had possession of the claimed invention.

Art Unit:

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Art Unit:

5. Claims 19-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiedeman in view of Japanese document no. 4123534.

Wiedeman discloses a mobile communication terminal equipment 501 containing a satellite transceiver 520 including a satellite transmission/reception circuit for communicating with a satellite system, a terrestrial transmission/reception circuit 503 for communicating with a terrestrial system, a signal input/output for inputting and outputting signals to/from the user and a connection controller and switching means 530,531 for selectively connecting the signal input/output circuit to one of the satellite transceiver and terrestrial transceiver. Wiedeman does not disclose a portable set disconnectable from the satellite transceiver. However, the above Japanese document discloses a portable set 100,140,154 for communicating to a local area, terrestrial system when disconnected from a different transceiver, or mover, 102 for communicating to another system such as a satellite system but can communicate and connect with either of the local networks when connected with the mover 102. Therefore, it would have been obvious to one having ordinary skill in the art to apply this portable unit communication technique of the above Japanese document to the system of Wiedeman for the purpose of allowing the phone to be more compact when only communicating with a particular local system. As to the other local area network being able to communicate with a satellite system, such would have been obvious to one of ordinary skill in the art since one would want to communicate at a much farther distance. It is considered that the above modified system contains satellite and terrestrial control means (contained in microprocessor CONT) for controlling signal transmission

Art Unit:

and reception and command input means for inputting a user's command relating to the operation of the switching means as recited in claims 20-22 and 24-26. It is also considered that particular control signals are transmitted between the satellite and terrestrial control means and command input means in order for the device to properly operate and switch to the appropriate communication system.

Art Unit:

Allowable Subject Matter

6. Claims 1-18 are allowed.

Response to Arguments

7. Applicant's arguments filed 11/30/99 have been fully considered but they are not persuasive.

Applicant argues with respect to the 112, 1st paragraph rejection that claims 19-26 do not require that the satellite transceiver be portable and that the specification does not describe a satellite transceiver "mounted" in a vehicle. However, although the claims do not specifically recite that the satellite transceiver be portable, the claims do encompass such an embodiment. And given the fact that all the embodiments contained within the specification involve the use of a vehicle to transport the satellite transceiver, it is still considered that there is no proper support for these claims. It is also still considered that the specification does describe a satellite transceiver mounted in a vehicle as evidenced by the numerous times the word "mounted" is used throughout the specification (including the third embodiment, in col. 4, lines 26-28 and in col. 5, lines 50-54). As to the argument that the object of the invention is to reduce the size of the satellite transceiver is directed to a transceiver not mounted in a vehicle, the examiner disagrees. In col. 3, line 63 - col. 4, line 3, the reduction in size of the satellite transceiver makes it beneficial to be placed adjacent to the driver's seat in a vehicle.

Applicant argues with respect to the 103 rejection that for terrestrial communication to

Art Unit:

occur, as taught by the Japanese reference, after the individual mover 102 is disconnected, the telephone set 154 must be reconnected to the individual mover 102. However, it is still considered that the '534 reference teaches that a totally portable device can have two separate housings, one for terrestrial communication and one for satellite communication and can be disconnectable when it is desired to reduce the size of the overall device. Also note the suggestion within the reference that separate transceivers, or movers, could be interchanged (page 7, line 30 - page 8, line 5 from translation).

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Art Unit:

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Urban whose telephone number is (703) 4385.

EFU

February 11, 2000


EDWARD F. URBAN
PRIMARY EXAMINER